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09/421,038	10/20/1999	CHASE A. HAFNER	1668	3569

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09421038

Filing Date: 7 May 2003

Appellant(s): Hafner et al.

Jeremy J. Curcuri, Esq., For Appellant


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GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 August 2005 appealing from the Office action mailed 3 March 2005.

EA 

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5,003,584	Benyacar et al.	03-1991
5,915,006	Jagadish et al.	06-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 3 March 2005, except that three lines have now been made bold in para. 5 and two typographical errors have been corrected where indicated by footnotes.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12 November 2004 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benyacar et al.
5. Benyacar et al. teaches a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising (col. 10 lines 44-59): receiving a customer record (*AMA record 370*) at billing system 140, where the record includes the data shown in Fig. 3 (col. 7 line 16 to col. 10 line 27); **executing the steps of Fig. 2 with the system of Fig. 1 (col. 5 line 41 to col. 7 line 15, and col. 10 lines 20-43), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine, including a *non-application specific, configurable system* (para. 7-9 below) that process input data to produce output data where the processing is dictated by a set of *configurable rules* (para. 8 and 9 below); and generating the caller's and sponsor's billing records from the *AMA record*, including rendering discounts applicable to the customer.**
6. Benyacar et al. does not explicitly teach accumulating the data in a plurality of predetermined target accumulators. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference teaches (col. 10 lines 44-59) substantially manipulating the data, which inherently entails placing data in computer memory locations, which reads on predetermined target accumulators.
7. Benyacar et al. teaches three a sets of parameters, *SCI*, *DDI* and *ASI*, that provide flexibility in various applications (col. 10 lines 22-27), including CSN arrangements other than that of AT&T (col. 5 lines 60-62), which reads on "a non-application specific system".
8. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity,

deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

9. The instant application contains no such clear definition for the phrases "configurable system" and "configurable rules". Indeed, the examiner could not find these phrases in the specification, and could only one reference (p. 3 line 17) to configuring a rules-based engine. Hence, the examiner is required to give the terms their broadest reasonable interpretation. The *Microsoft Press Computer Dictionary* defines "configuration" and "configuration file" such that they apply to any computer. Since the reference teaches a computer whose memory, etc., can be changed, it teaches a "configurable system". The *Microsoft Press Computer Dictionary* definitions do not apply to software changes not established through configuration files. The broader definition in the *Merriam-Webster Online Dictionary* is used to establish that "configurable rules" are rules set up for operation in a particular way. The reference teaches that (para. 6 above).
10. Claims 1-4, 6-14 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagadish et al.
11. Jagadish et al. teaches (independent claims 1, 10 and 11) a method, system and computer readable medium for managing information and rendering discounts in a billing system, the method comprising: receiving a customer record (*AMA record*) at *billing analysis system 112* (col. line 22); and executing the steps of Fig. 2 with the system of Fig. 1a (col. 4 line 35-49), which reads on establishing both a rule-based accumulation engine and a rule-based discount engine, including a *non-application specific, configurable system* (para. 12 below) that process input data to produce output data where the processing is dictated by a set of *configurable* rules (para. 12 below); said processing the record and accumulating the data in *SD 113*, in a plurality of computer memory cells, which reads on a plurality of predetermined target accumulators, and rendering discounts applicable to the customer, which reads on processing the plurality of target accumulators with the discount engine to render discounts applicable to the customer.

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12. Jagadish et al. teaches a flexible system of billing management (col. 4 lines 23-34), which reads on "a non-application specific system". Jagadish et al. also teaches a *configurable system* and a set of *configurable* rules for the reasons given in para. 8 and 9 above.¹
13. Jagadish et al. also teaches: (claims 2-4, 7, 8, 12-14, 17 and 18) the Fig. 2 series of process steps to be applied based on the number of customer lines, which reads on establishing a rules table to apply at least one rule or function when dictated by the record type, and establishing at least one simple rule for processing the record to evaluate discount application; (claims 6 and 16) adding the number of the telephone line to the record (col. 4 lines 47-54), which reads on assigning a logical name to a source field, where the accumulation engine processes the record using the logical name; and (claims 9 and 19) establishing at least one compound rule composed of simple rules (col. 5 lines 10-23).
14. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Jagadish et al.² Jagadish et al. does not teach that the rules table directs the accumulation engine to pass data directly to a target accumulator when dictated by the record type. Because the initial purpose of the reference invention is to aggregate all the phone line records for any given customer, it would have been obvious to one of ordinary skill in the art, at the time of the invention, that processing resources could be saved by bypassing this step, and passing the data directly to the target accumulators in *SD 112*, when the customer has only one line.

(10) Response to Argument

A. Argument for Independent claims 1, 10 and 11 rejected under 35 U.S.C. 102(b) as being anticipated by Benyacar et al.

As noted by the appellant (p.5), the Board has previously adjudicated this application. On 7 September 2004, the Board affirmed a final rejection mailed on 29 March 2002. Subsequently, in a filing on 12 November 2004, appellant amended only the three independent claims 1, 10 and 11. This amendment was essentially the same three-line

¹ In the original, the reference paragraph numbers were erroneously given as "9 and 10".

² In the original, this line reads "Claims 5 and 15 are rejected under 35 U.S.C. 102(e) as being obvious over Jagadish et al." (emphasis added).

limitation added at two places in claims 1 and 11, and at one place in claim 10. The first addition to claim 1 was as follows, where underlines indicate added material:

Establishing a rule-based accumulation engine including a non-application specific, configurable system that processes input data to produce output data where the processing is dictated by a set of configurable rules;

This amendment for the *accumulation engine* was also added for a *discount engine* in each claim 1 and 11. (See the last para. on p. 5 of appellant's brief.) The Office mailed the new final rejection copied above, on the first action after RCE, on 3 March 2005. Appellant filed the present appeal.

At the bottom of p. 6 appellant opines that the examiner has not given full consideration to the amendments made with the RCE. The examiner does not agree. The amendments are addressed in rejection para. 6 (the phrase in bold) and in para. 7-9 inclusive. The rejection is much the same as it was in March 2002 because little has changed. In particular, the issue now before the Board is the same as the issue before the Board in 2004. In both cases, appellant is asking the Board to permit an interpretation of claim language that the examiner has found to be unsupported.

At issue are the phrases "configurable system" and "configurable rules". Unless the specification contains a "clear definition" of these terms (MPEP § 2111.01), the examiner is required to give them their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). This was explained to appellant in para. 8 of the rejection quoted above.

Para. 9 of the rejection concluded: "The instant application contains no such clear definition for the phrases "configurable system" and "configurable rules". Indeed, the examiner could not find these phrases in the specification, and could only [find] one reference (p. 3 line 17) to configuring a rules-based engine. Hence, the examiner is required to give the terms their broadest reasonable interpretation." Para. 9 goes on to give this broadest reasonable interpretation and to show where it is taught by Benyacar et al.

Appellant dismisses this key part of the rejection with the statement (top of p. 7), "The examiner simply states that Benyacar et al. reads on establishing both a rule-based accumulation engine and a rule-based discount engine." Applicant also argues (pp. 7-8) that the examiner is relying on his "previous broadest [reasonable] interpretation of the rule-based engine features."

The specific technical features added with the new amendment are addressed in rejection para. 6 and 7 above. Appellant traverses these new details in p. 7, beginning with the second sentence. The examiner maintains that this argument is unsupported by the specification and therefore specious. Appellant's argument is not based on the legally required broadest-reasonable interpretation of the claim terms developed by the examiner in para. 8 and 9 of the above rejection.

B. Argument for claims 1-4, 6-14 and 16-19 rejected under 35 U.S.C. 102(e) as being anticipated by Jagadish et al.

Here the independent claims 1, 10 and 11 are rejected with a second reference, and that reference is also used to reject most of the dependent claims. Appellant again argues that there are special features of the claims not being given full consideration by the examiner. The examiner has given the claim language all the consideration that the law permits. Applicant's problem is stated as follows in para. 9 of the rejection: "The instant application contains no such clear definition for the phrases "configurable system" and "configurable rules". Indeed, the examiner could not find these phrases in the specification, and could only [find] one reference (p. 3 line 17) to configuring a rules-based engine."

It is significant that appellant never challenges this part of the rejection by showing where in the specification there is support for the new claim language. That is because there is no more support than the examiner has indicated.

C. Argument for claims 5 and 15 rejected under 35 U.S.C. 103(a) as being obvious over Jagadish et al.

Appellant offers no further argument against the rejection.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Conferees:

Raquel Alvarez 

Eric W. Stamber 